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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,843	04/06/2006	Shinichi Yanagi	288920US0PCT	5093
22850	7590	02/13/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
OLADAPO, TAIWO				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
02/13/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/574,843

Applicant(s)

YANAGI ET AL.

Examiner

TAIWO OLADAPO

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment dated 10/24/2008 has been considered and entered for the record. The amendment and applicant's arguments overcome the previous rejections. Therefore, all previous rejections are withdrawn and new rejections are made below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6 – 9, 14 – 23, are rejected under 35 U.S.C. 102(b) as being anticipated by
Lowe (US 3,184,411)

4. In regards to claims 1, 9, 14, 15 Lowe teaches a lubricating oil composition comprising a reaction product of succinimide and phosphorus pentasulfide which are used in the oils in preferred amounts of from 1 to 10% which anticipates the ranges in claims 14, 15(column 2 lines 50 – 52; column 3 lines 20 – 23).

5. In regards to claims 7, 8, 23, Lowe teaches the lubricating oil composition as claimed which is suitable for lubricating transmissions automatic or continuously variable having wet clutch or wet brake.

6. In regards to claims 6, 16, 17, Lowe teaches the lubricating oil composition wherein the lubricating oil can be naphthenic or paraffinic oils which are mineral oils, or they can be synthetic oils (column 2 lines 55 – 60).
7. In regards to claims 18 – 22, Lowe teaches the lubricating oil having mineral or synthetic base oil and the reaction product as claimed, thus intrinsically having the viscosity and acid contents %C_A in the range(s) recited. “Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)
8. Claims 1, 3, 5 – 8, 14 – 23, are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi (US 4,483,775)
9. In regards to claims 1, 3, Yamaguchi teaches a lubricating oil additive comprising a reaction product or complex of a metal salt of diisopropyl dithiophosphoric acid and (component A) and succinimide (component B) (column 1 line 50 – column 2 line 25). The metal salt of diisopropyl dithiophosphoric acid is a phosphosulfurized hydrocarbon having two alkyl groups having ether bonds with a phosphorus compound (column 1 lines 50 – 67 structure).
10. In regards to claim 5, Yamaguchi teaches the lubricating oil additive, wherein the alkyl groups have 6 carbon atoms which meets the claimed limitation (column 1 lines 50 – 67 structure).

11. In regards to claim 6, Yamaguchi teaches a lubricating oil composition wherein the oil is derived from petroleum or synthetic sources, which are mineral and synthetic oils (column 6 lines 60 – 65).
12. In regards to claims 7, 8, 23, Yamaguchi teaches the lubricating oil comprising the base oil and phospho-sulfurized hydrocarbon additives according to the claimed invention, which are suitable as automatic transmission or continuously variable transmission fluids for wet clutches or wet brakes.
13. In regards to claims 14, 15, Yamaguchi teaches the lubricating oil composition wherein the phospho-sulfurized hydrocarbon (diisopropyl dithiophosphoric acid) and succinimide additive is present in the amount of preferably 1.5 to about 6 wt. % (column 4 lines 58 – 61).
14. In regards to claims 16, 17, Yamaguchi teaches the lubricating oil composition which comprises mineral or synthetic oil as previously stated.
15. In regards to claims 18 – 22, Yamaguchi teaches the lubricating oil having mineral or synthetic base oil and the reaction product as claimed, thus intrinsically having the viscosity and acid contents %C_A in the range(s) recited. “Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Response to Arguments

16. Applicant's arguments with respect to the references used in the previous office action are persuasive. Kablaoui and Hata do not disclose the reaction of a succinimide with a phosphorus-containing compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Glenn A Caldarola/
Acting SPE of Art Unit 1797